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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/786,917

02/25/2004

Teruhiko Tobinai

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EXAMINER

CHIESA, RICHARD L

ART UNIT

PAPER NUMBER

1724

MAIL DATE

DELIVERY MODE

05/11/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/786,917	Applicant(s) TOBINAI ET AL.	
	Examiner Richard L. Chiesa	Art Unit 1724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 March 2006 and 05 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3-13-06 & 5-22-06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The amendment filed on May 5, 2006 has been entered. The remarks and supplemental reissue declaration filed on March 13, 2006 have been entered.

Reissue Applications

2. The supplemental reissue declaration filed on March 13, 2006 is defective (see 37 CFR 1.175 and MPEP § 1414) because the claim for foreign priority is deficient. This is because applicants have not made a proper claim for foreign priority within four months of the filing of the instant application as required by 37 CFR 1.55(a)(1)(i). Applicants must now file a petition and fee as required by 37 CFR 1.55(c)(1)-(3) to accept a delayed claim for priority under 35 USC 119(a)-(d).

3. Claims 1-33 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect in the declaration is set forth in paragraph 2 above in this Office action.

4. In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed.

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Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

“Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant.”

See MPEP § 1414.01.

5. Claims 14-22, 25-27, 29, and 30 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to claim subject matter that applicants previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope of claim subject matter surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

The recitation “axially extending projections” defined in the patented claims but omitted in the reissue claims 14-22, 25-27, 29, and 30 was a key limitation added to overcome an art rejection in the patented application. Furthermore, applicants argued on page 9, lines 4-9 of the amendment filed on August 16, 2001 in the patented application (SN 09/493,363) that neither

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U.S. Patent No. 4,073,278 to "Glenn nor any other cited references" discloses applicants' coupling "projections". It would appear that couplings without axial projections constitutes surrendered subject matter. The substitute limitations now present in the above-noted reissue claims do not recite any coupling "projections" and appear to be merely restating in different phraseology but of somewhat narrower scope the relative rotation between the throttle valve and air valve which was originally present in the patented application at filing or in the preliminary amendment dated April 3, 2000. In this situation, the reissue claims must contain a substitute (i.e. replacement) limitation that is related but narrower or broader than the key limitation in order to avoid a recapture rejection. Consequently, it would appear that applicants at the very least must also recite in the above-noted reissue claims the coupling projections.

Claim Rejections - 35 USC § 112

6. Newly-amended claims 23 and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. Claims 23 and 24 are confusing because claim 23 recites the limitations "the throttle valve shaft" and "the air valve shaft" in lines 12 and 13. There is apparently insufficient antecedent basis for these limitations in the claim.

Response to Arguments

7. Applicants' arguments filed on May 13, 2006 have been fully considered but they are not persuasive. Contrary to applicants' comments on pages 13-15 of the remarks filed on March 13, 2006, the axially extending projections were indeed necessary to define over the prior art in the

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patented application. This is evidenced by applicants' statement on page 9, lines 4-9 of the remarks filed on August 16, 2001 which reads: "Therefore, neither Glenn nor any other cited references discloses applicants' specific concept, construction nor its advantages in which the air and throttle shafts are coaxial and a coupling is disposed between the scavenging air and fuel mixing passages and the coupling has projections which are selectively engageable to close the air valve at idle conditions, provide a partial opening of the throttle valve before opening the air valve and upon further opening of the throttle valve the air valve is simultaneously opened therewith." In any case, the examiner has indicated below how the rejected reissue claims can be amended in order to place this case into condition for allowance.

Allowable Subject Matter

8. Upon the filing of a proper supplemental reissue oath/declaration, claims 1-13, 28, and 31-33 would be allowed.

9. Upon the filing of a proper supplemental reissue oath/declaration, claims 14-22, 25, 29, and 30 would be allowable if : (A) the phrase --including an air valve shaft-- was inserted between "valve" and "carried" in claim 14, line 3 and claim 29, line 3; (B) the phrase --including a throttle valve shaft-- was inserted between "valve" and "carried" in claim 14, line 6 and claim 29, line 5; (C) the phrase --with projections-- was inserted between "coupling" and "selectively" in claim 14, line 8, and between "coupling" and "interconnecting" in claim 29, line 7, and (D) the word --shaft-- was inserted between "valve" and "and" and between "valve" and "so" in claim 14, line 8 and claim 29, line 7.

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10. Upon the filing of a proper supplemental reissue oath/declaration, claims 23 and 24 would be allowable if the phrase --including an air valve shaft-- was inserted between “valve” and “carried” in claim 23, line 3 and the phrase --including a throttle valve shaft-- was inserted between “valve” and “carried” in claim 23, line 5.

11. Upon the filing of a proper supplemental reissue oath/declaration, claims 26 and 27 would be allowable if the phrase --with projections-- was inserted between “coupling” and “operably” in claim 26, line 9.

Conclusion

12. Applicants are notified that any subsequent amendment to the specification and/or claims must comply with 37 CFR 1.173(b).

13. Applicants’ amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard L. Chiesa whose telephone number is (571) 272-1154.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duane S. Smith, can be reached at (571) 272-1166.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1700 receptionist whose telephone number is (571) 272-1700.

Facsimile correspondence must be transmitted through (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Richard L. Chiesa
June 5, 2006

Richard L. Chiesa

**RICHARD L. CHIESA
PRIMARY EXAMINER
ART UNIT 1724**

April 24, 2007